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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,381

05/09/2005

Shinji Koube

8007-1091

2839

466 7590 02/21/2007
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EXAMINER

TOSCANO, ALICIA

ART UNIT

PAPER NUMBER

1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/534,381	Applicant(s) KOUBE ET AL.	
	Examiner Alicia M. Toscano	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/06 8/9/05 5/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biesiada (US 6111004) in view of Hayashi (JP 08059938A).

Biesiada discloses polyester plasticizers for halogen containing polymers. Said polyester plasticizers may comprise a diol component comprising 2-methyl-1,3-propanediol and 1,2-propanediol, or additional aliphatic diol, an acid component of adipic acid and a chain terminator of a fatty acid mixture (See example 1). Use of 100% adipic acid, or an acid component comprising 100 mol%, is disclosed in Column 2 Line 66. The ratio of 2-methyl-1,3-propanediol to 1,2-propanediol is disclosed in Column 1 line 34 to be 1:3 to 3:1, or a diol component comprising 100 mole% 2-methyl-1,3-

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propanediol to 300 mole% 1,2-propanediol. Said range encompasses 2-methyl-1,3-propanediol and aliphatic diol requirements of Claims 1 and 2.

The polymer structure is disclosed in formula I, Column 2. Since one "n" repeat unit is at least about 186 g/mol and the rest of the polymer is about 188 g/mol, it is the Examiners position that the range of n from 1 to 12 encompasses the molecular weight range requirements of Claim 3. Said halogen containing polymers may be a homo- or co-polymer of vinyl chloride [0016], as required by Claim 4.

Biesiada does not disclose the use of 3-methyl-1,5-pentanediol. Hayashi discloses polyester plasticizers for vinyl chloride systems. Said plasticizers comprise 3-methyl-1,5-pentanediol. Examples A-D disclose systems with 3-methyl-1,5-pentanediol and Examples E and F disclose systems without 3-methyl-1,5-pentanediol. Systems containing 3-methyl-1,5-pentane diol have superior paint appearance and smoothness resulting in chip-proof coatings [0031].

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Biesiada the use of 3-methyl-1,5-pentanediol, as taught by Hayashi, in order to create a paint coating system with superior appearance and smoothness. The mol% of 3-methyl-1,5-pentanediol are disclosed in Table 1. All the requirements set forth in Claim 1 are met.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lang (US 2003/0114564) and Mizumoto (JP 61078827A) are cited as equivalents to Biesiada.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is 571-272-2451. The examiner can normally be reached on Monday to Friday 8:30 AM to 5 PM.

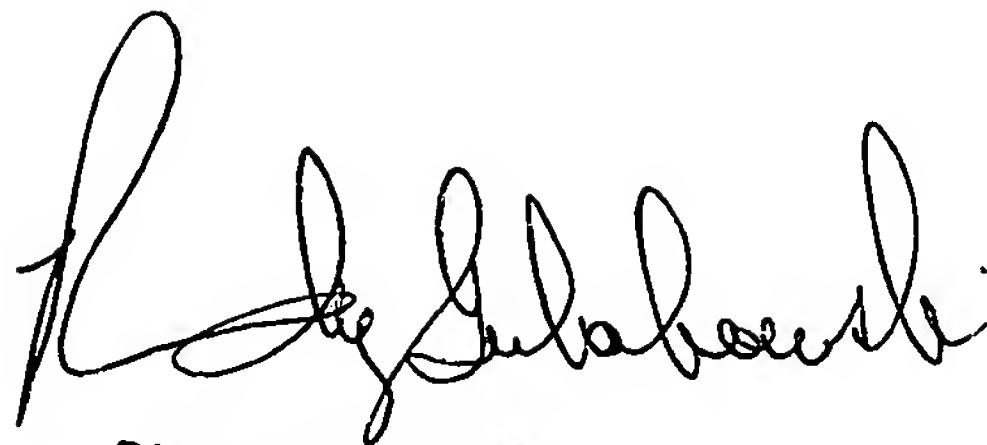
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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